REMARKS

Claims 20-51 remain pending and at issue in this application. Claims 20-27, 40-42 and 45-46 have been rejected under 35 U.S.C. §102(b) as being anticipated by GB 1,121,849. Claims 28-39, 43, 44, and 47-51 have been rejected under 35 U.S.C. §103(a) as obvious in light of GB 1,121,849 in view of U.S. Patent No. 4,437,904 (MacCaven). In light of the claim amendments presented above and the following remarks, applicants submit pending claims 20-51 to be in condition for allowance and request reconsideration and withdrawal of the pending rejections.

I. REJECTIONS UNDER 35 U.S.C. §102(b)

Independent claims 20 and 45 have been amended to recite, *inter alia*, a method and apparatus for annealing and manufacturing billets including a billet of a light metal or a light metal allow and at least one metallic wire. See generally, page 1, paragraph 2 and page 3, paragraph 2 of the specification. Claims 20 and 45 further recite that the material of contact elements is adapted to the material of the billets such that substantially no material from the billet diffuses into the contact element.

GB 1,121,849 does not disclose an annealing apparatus for annealing metallic billets, namely a metallic wire or a bundle of such metallic wires. Moreover, GB1,121,849 does not disclose that the material of contact elements is adapted to any specific material of the billets, much less a billet material such that substantially no material from the billet diffuses into the contact element. Rather, GB 1,121,849 simply discloses a method and a device for drying and heat treatment of an aluminium foil, see generally page 2, lines 97 through 103.

Because GB 1,121,849 does not suggest or disclose, in any way, a billet of a light metal or a light metal allow, in the form of at least one metallic wire, or that the material of contact elements is adapted to the material of the billets such that substantially no material from the billet diffuses into the contact element as recited by independent claims 20 and

45, either expressly or inherently, these claims cannot be anticipated[1] thereby. Reconsideration and withdrawal of the anticipation rejection is hereby respectfully requested.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 28-39, 43, 44, and 47-51 have been rejected as obvious in light of GB 1,121,849 in view of MacCaven.

As discussed above in Section 1, independent claims 20 and 45 recite, *inter alia*, a method and apparatus for annealing and manufacturing billets including a billet of a light metal or a light metal allow in the form of at least one metallic wire wherein the material of contact elements is adapted to the material of the billets such that substantially no material from the billet diffuses into the contact element.

GB 1,121,849 does not disclose or suggest a method or an apparatus for manufacturing or annealing wires of a light metal or light metal alloy wherein the material of the contact element is adapted to the material of the wire such that substantially no diffusion arises between the contact element material and the wire material. GB 1,121,849 discloses a method of heat treatment of aluminum *foil* including conducting rollers may be of any convenient conducting material. "For lightness these rollers may be hollow aluminum shells having sufficient hollow cross section to allow free current flow with steel inserts at each end to provide hard wearing machined journals for mounting the rollers on bearings." See page 2, lines 81 through 84. Thus, GB 1,121,849 simply discloses that aluminum can be used in connection with steel inserts in

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[1] "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. §102 rejection. See MPEP § 2131.01.

order to form light weight rollers that are wear resistant enough for use in a foil heat treatment apparatus. GB 1,121,849 does not suggest or disclose that the material of the contact element is adapted to the material of the wire such that substantially no diffusion occurs between the contact element material and the wire material, rather GB 1,121,849 is simply concerned with the weight of the rollers.

MacCraven adds little to the teachings of GB 1,121,849. In particular, MacCraven simply teaches another method of heat treatment of drawn wire including the step of holding the wire at a selected elevated temperature for a selected time period to achieve the desired wire properties. MacCraven does not suggest or disclose that the material of the contact element is adapted to the material of the wire such that substantially no diffusion arises between the contact element material and the wire material.

None of the cited references, taken alone or in combination, is sufficient to set forth a *prima facie* case of obviousness[2] because they fail to teach or suggest all the claim limitations. Further, the cited references are simply concerned with the weight of the contact elements and/or the energy need of the process, without recognizing and addressing the problem of diffusion and product life of the contact elements. Because GB 1,121,849 and MacCraven do not, alone or in combination, teach or suggest each and every element recited in independent claims 20 and 45, either expressly or inherently, these claims are not rendered obvious. Reconsideration and withdrawal of the obviousness rejection is hereby respectfully requested.

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[2] To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

III. CONCLUSION

For these foregoing reasons, applicants submit that the application is in condition for allowance. If there are any additional fees or refunds, the Commissioner is hereby directed to charge or debit Deposit Account No. 13-2855. Reconsideration and withdrawal of the rejections is respectfully requested.

Respectfully submitted for,

MARSHALL, GERSTEIN & BORUN LLP

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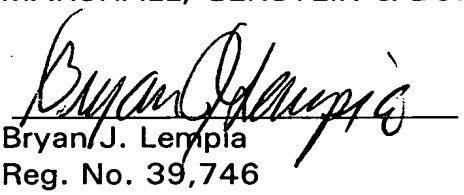
By: 

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